

REMARKS

Upon entry of the present amendment, claims 1-2 and 6-17 will remain pending in the above-identified application with claims 1-2, 6-11 and 16-17 standing ready for further action on the merits, and claims 12-15 being withdrawn from consideration based upon an earlier Restriction Requirement.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, claim 1 has been amended to more particularly recite that the component (B) is an adhesive "which comprises a foaming agent and at least one selected from a thermosetting resin and a photostetting resin". Support for this amendment occurs in original claims 4-5, now cancelled.

Based upon the above considerations, entry of the present amendment is respectfully requested.

Restriction Requirement

Applicants acknowledge the prior Restriction Requirement, and their election to prosecute the invention of Group I (claims 1-11, drawn to a laminate); and Group III (claims 16-17, drawn to an article).

Even though Applicants have made an election in order to further prosecution of the case, Applicants also ask for reconsideration and withdrawal of the outstanding Restriction

Requirement. The basis of the traversal is that no undue burden would be placed upon the Examiner to consider each of pending claims 1-17 at present.

Claim Rejections Under 35 USC § 102

Claims 1-3 and 16-17 have been rejected under 35 USC § 102(b) as being anticipated by Akada (US 5,304,418). Reconsideration and withdrawal of this rejection is respectfully requested based upon the following considerations.

The component (B) of the present invention, which is an adhesive that comprises a foaming agent and at least one selected from a thermosetting resin and a photosetting resin defined in claim 1 is not disclosed by Akada.

Akada teaches and provides for a dicing-die bonding film comprising an ultraviolet transmitting substrate having provided thereon an ultraviolet-curable pressure-sensitive adhesive layer and an adhesive layer in this order, said pressure-sensitive adhesive layer having been partly ultraviolet-cured to have cured parts and uncured parts. However, it is silent about a foaming agent in the ultraviolet-curable pressure-sensitive layer.

These distinguishing facts evidence that the present invention is not anticipated by Akada and accordingly that the present invention is novel under the provisions of Title 35 of the United States Code (USC).

Claim Rejections Under 35 USC § 103

Claims 1-11 and 16-17 have been rejected under 35 USC § 103(a) as being unpatentable over Aizawa (US 5,609,954) in view of Akada (US 5,304,418). Reconsideration and withdrawal of this rejection is respectfully requested based on the following considerations.

Aizawa discloses adhesive materials comprising a support having on at least one side thereof a strippable pressure sensitive adhesive layer. However, as seen from column 2, line 47 to column 3, line 26, the resins used or disclosed in the strippable pressure sensitive adhesive layer are thermoplastic resins. In the examples described in column 3, lines 10 to 13, acrylic pressure-sensitive adhesives, rubber pressure-sensitive adhesives, styrene-conjugated diene block copolymer are listed. And at column 3, lines 23 to 25, it is described that "Natural rubber or reclaim rubber may also be used as a base polymer so long as the above described elasticity characteristics are satisfied." All of these resins are thermoplastic resins. Moreover, the strippable pressure sensitive adhesive layer comprises the thermoplastic resins and blowing agent (which is same meaning as a foaming agent), and does not contain a polymerizable monomer and a blowing agent as apparently being contended by the USPTO.

In contrast to the teachings of Aizawa, Akada discloses an ultraviolet-curable pressure-sensitive adhesive layer with a cured part and an uncured part. The cured part is obtained by curing a

photocurable compound. The uncured part comprises a photocurable compound, not resin. In other words, the cured part comprises resin and the uncured part comprises monomers, not resin. And the resin is a so-called photosetting resin.

The USPTO contends that it would have been obvious to one having ordinary skill in the art to utilize Akada's teaching of using an adhesive layer over the PSA layer in the invention of Aizawa.

However, as described above the resin in Akada's PSA layer is a photosetting resin, whereas Aizawa's resin in its PSA layer is a thermoplastic resin.

Thus, even if *arguendo* one skilled in the art were motivated to use Aizawa's PSA layer in place of Akada's PSA layer in Akada's laminate, any such laminate so obtained would be different from the laminate of the present invention. This is because the resin in Akada's component (B) corresponding to its PSA layer is a thermosetting resin or photosetting resin, while the PSA layer resin of Aizawa is a thermoplastic resin.

Accordingly, based upon the above considerations, it is clear that the cited references of record, Akada and Aizawa, provide no teaching or disclosure which would motivate those of ordinary skill in the art to arrive at the present invention as claimed. Absent such motivation in the cited art, the outstanding rejection under 35 USC § 103(a) is not sustainable.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance, clearly indicating that the claims under consideration at present (claims 1-2, 6-11 and 16-17) are allowable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 3-5 have been canceled.

The claims have been amended as follows:

1. (Amended) A laminate comprising: (A): a substrate, (B): an adhesive [that becomes capable of release when receiving energy] which comprises a foaming agent (an) ^{and} at least one selected from a thermosetting resin and a photosetting resin, and (C): an adhesive that does not become capable of release even when receiving energy, which are laminated sequentially.

6. (Twice Amended) The laminate according to claim 1, wherein [the adhesive (B) that becomes capable of release when receiving energy and] the adhesive (C) that does not become capable of release even when receiving energy [are (B-1): a crosslinkable polymer containing a foaming agent, and] is (C-1) : a crosslinkable polymer [, respectively].

7. (Amended) The laminate according to claim 6, wherein [the crosslinkable polymer] the adhesive (C) is a thermosetting resin and/or a photosetting resin.

9. (Twice Amended) The laminate according to claim 1, further comprising (B'): an adhesive [that becomes capable of release when receiving energy] which comprises a foaming agent and at least one selected from a thermosetting resin and a photosetting resin, (B') being same as or different from the adhesive (B), and (A'): a substrate same as or different from the substrate (A), which are sequentially laminated on an adhesive layer surface of the adhesive (C).

10. (Amended) The laminate according to claim 9, wherein: (B) and/or (B') are photosetting resins [of a crosslinkable polymer]; and (C) and/or (C') are thermosetting resins [of a crosslinkable polymer].